

PTO/SB/30 (5/2000)

Approved for use through xx/xx/xxxx. OMB 0651-0031  
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number

# **REQUEST FOR CONTINUED EXAMINATION (RCE) TRANSMITTAL**

Subsection (b) of 35 U.S.C. § 132, effective on May 29, 2000,  
provides for continued examination of an utility or plant application  
filed on or after June 8, 1995.

See The American Inventors Protection Act of 1999 (AIPA).

Express Mail No	EV 313 842 467 US
Application Number	09/281,717
Filing Date	March 30, 1999
First Named Inventor	Baxter et al.
Group Art Unit	1631
Examiner Name	M. Moran
Attorney Docket No.	9811-008-999

This is a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114 of the above-identified application.

**NOTE:** 37 C.F.R. § 1.114 is effective on May 29, 2000. If the above-identified application was filed prior to May 29, 2000, applicants may wish to consider filing a continued prosecution application (CPA) under 37 C.F.R. § 1.53 (d) (PTO/SB/29) instead of a RCE to be eligible for the patent term adjustment provisions of the AIPA. See Changes to Application Examination and Provisional Application Practice, Interim Rule, 65 Fed. Reg. 14865 (Mar. 20, 2000), 1233 Off. Gaz. Pat. Office 47 (Apr. 11, 2000), which established RCE practice.

## 1. **Submission required under 37 C.F.R. § 1.114**

- a. ☒ Previously submitted
- i. ☒ Consider the amendment(s)/reply under 37 C.F.R. § 1.116 previously filed on October 16, 2003  
(Any unentered amendment(s) referred to above will be entered).
- ii. ☐ Consider the arguments in the Appeal Brief or Reply Brief previously filed \_\_\_\_\_
- iii. ☒ Other: Statement that cited reference Scanlan was commonly owned by Applicant at time the instant invention was made, see pp. 14-15 of amendment/response filed October 16, 2003.
- b. ☒ Enclosed
- i. ☒ Amendment/Reply
- ii. ☐ Affidavit(s)/Declaration(s)
- iii. ☐ Information Disclosure Statement (IDS)
- iv. ☒ Other: Statement of the Substance of the Interview. \_\_\_\_\_

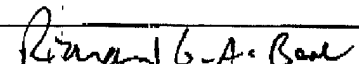
## 2. **Miscellaneous**

- a. ☐ Suspension of action on the above-identified application is requested under 37 C.F.R. § 1.103(c) for a period of \_\_\_\_\_ months.  
(Period of suspension shall not exceed 3 months; Fee under 37 C.F.R. § 1.17(f) required)
- b. ☒ Other Certificate of Limited Recognition Under 37 C.F.R. § 10.9(b).

## 3. **Fees**

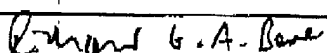
- The RCE fee under 37 C.F.R. § 1.17(e) is required by 37 C.F.R. § 1.114 when the RCE is filed
- a. ☒ The Director is hereby authorized to charge the following fees, or credit any overpayments, to Pennie & Edmonds LLP Deposit Account No. 16-1150:
- i. ☒ RCE fee required under 37 C.F.R. § 1.17(e), estimated to be \$ 385.00 (small entity fee)
- ii. ☒ Extension of time fee required under 37 C.F.R. §§ 1.136 and 1.17, estimated to be \$ 210.00 for a two month extension (small entity fee), the request for which is being made herewith
- iii. ☐ Other
- b. ☐ Check in the amount of \$ \_\_\_\_\_ enclosed
- c. ☐ Payment by credit card (Form PTO-2038 enclosed)

## **SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT REQUIRED**

Name (Print/Type)	Richard G. A. Bone for Samuel B. Abrams, Reg. No. 30,605	Limited Recognition Under 37 C.F.R. § 10.9(b) (Copy of Certificate attached hereto)
Signature		Date December 16, 2003

## **CERTIFICATE OF MAILING OR TRANSMISSION**

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:  
Commissioner For Patents, P.O. Box 1450, Mail Stop RCE, Alexandria, VA 22313-1450, or by facsimile transmitted to fax no. 1-703-308-4242 to the U.S. Patent and Trademark Office on the date indicated below.

Name (Print/Type)	Richard G. A. Bone	Registration No. (Attorney/Agent)	Limited Recognition
Signature		Date	December 16, 2003

CA1: 364093.1

**OFFICIAL**By Facsimile**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE****RECEIVED  
CENTRAL FAX CENTER****DEC 16 2003**

Application of:	Baxter, <i>et al.</i>	Confirmation No.:	7561
Serial No.:	09/281,717	Art Unit:	1631
Filed:	March 30, 1999	Examiner:	M. Moran
For:	METHODS AND COMPOUNDS FOR MODULATING NUCLEAR RECEPTOR COACTIVATOR BINDING	Attorney Docket No.:	9811-008-999

**STATEMENT OF THE SUBSTANCE OF THE INTERVIEW**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants thank Examiner Moran for the telephonic interview of December 4, 2003, conducted with Applicants' representative, Richard G. A. Bone, and hereby submit a recordation of the substance of the interview, in response to the Interview Summary mailed December 8, 2003. The following items were discussed:

1) Entry of After-final Amendment:

The Examiner felt that some parts of our amendment filed October 16, 2003, were acceptable but that others were not. Because, according to PTO practice, an amendment after-final cannot be entered "in-part", none of the amendment has been entered. The Examiner indicated that an Advisory Action to this effect would follow.

2) New Matter Objection (c) in the July 16, 2003 Office Action:

The Examiner acknowledged that the form of language presented in Applicants' Amendment and Response, mailed October 16, 2003 would be acceptable but that it could not be entered for reasons discussed herein.

### 3) The Scanlan reference

Regarding our statements that Scanlan is not a reference; the Examiner indicated that they would, in principle, be acceptable but that, because they had not been entered, she would not be able to withdraw the rejection of record. She asked that, should Applicants file an RCE, then we should draw explicit attention to these statements, or reiterate them so that they could be properly entered.

### 4) Claim 1:

Regarding claim 1, the Examiner clarified that although she considers that the art objections presently of record would be obviated by the removal of Scanlan as a reference, she felt that a further search would be likely to reveal references to nuclear receptor structures other than the thyroid receptor. Thus, according to the Examiner, examination would proceed as with any other genus-species situation where, even though a claim is considered allowable over an elected species, it is not actually allowed until other species have been searched. Applicants' representative emphasized to the examiner that, although much art on nuclear receptor structures is known, she should focus her searches on locating any art that might disclose a structure of a coactivator binding sites.

### 5) Amendments to claims 2 – 8:

Examiner Moran also discussed the amendments to claims 2 – 8 that recite interaction of a compound with specific residues, as presented in Applicants' response of October 16, 2003. The Examiner requested that Applicants identify parts of the specification that call out the interactions for specific classes of residues. Applicants' representative pointed out language in the specification that described interactions between compounds and binding site residues but agreement was not reached with the Examiner.

The Examiner also objected to the term "at least one of" in the amended claims 2 – 8, suggesting that she could only identify support for interaction with sets of residues *in toto*, and not arbitrarily selected subsets. Applicants' representative pointed out language in the specification, but the Examiner was not convinced of its specificity.

### 6) Potentially allowable subject matter

The Examiner considered that, subject to the caveats herein, the subject matter of claims 2 – 8 could be allowable if rewritten in independent form (incorporating the steps of claim 1).

## 7) Procedural matters

Applicants' representative discussed various options with the Examiner for proceeding with the subject application.

Although Applicants do not believe any fee is due with this submission, please charge any requisite fee to Pennie & Edmonds LLP Deposit Account No. 16-1150. A copy of this sheet is enclosed for this purpose.

Respectfully submitted,

Date: December 16, 2003

Richard G. A. Bone

Richard G. A. Bone  
Limited Recognition Under 37 C.F.R. § 10.9(b)  
(Copy of Certificate attached hereto)

for Samuel B. Abrams, Reg. No. 30,605  
**PENNIE & EDMONDS LLP**  
1155 Avenue of the Americas  
New York, New York 10036-2711  
(212) 790-9090

---

CERTIFICATION OF FACSIMILE TRANSMISSION UNDER 37 C.F.R. 1.8(a)

I hereby certify that this paper is being filed with the United States Patent and Trademark Office by facsimile transmission on **December 16, 2003** to facsimile telephone number (703) 308-4242.

Richard G. A. Bone December 16, 2003  
Richard G. A. Bone